



11 AUG 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

MACMILLAN SOBANSKI & TODD, LLC  
ONE MARITIME PLAZA, FOURTH FLOOR  
720 WATER STREET  
TOLEDO, OHIO 43604-1619

In re Application of:	:	
BIGHAM, Ian, B., et al.	:	DECISION ON PETITION UNDER
U.S. Application No.: 10/538,814	:	37 CFR 1.47(a)
PCT No.: PCT/IB2003/006496	:	
International Filing Date: 12 December 2003	:	
Priority Date: 13 December 2002	:	
Attorney's Docket No.: 1-24194	:	
For: DEVICE FOR THE PRODUCTION OF	:	
COMB HONEY	:	

This decision is issued in response to applicants' "Petition Under 37 CFR 1.47(a) and 37 CFR 1.47(b) For Acceptance Of Declaration Under Circumstances Where One Joint Inventor Refuses To Sign A Substitute Declaration" filed 16 June 2006, treated herein as a petition under 37 CFR 1.47(a).<sup>1</sup> Applicants have paid the required petition fee.

**BACKGROUND**

On 12 December 2003, applicants filed international application PCT/IB2003/006496. The international application claimed a priority date of 13 December 2002, and it designated the United States. On 01 July 2004, the International Bureau communicated a copy of the international application to the United States Patent And Trademark Office (USPTO). The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 13 June 2005.

On 13 June 2005, applicants filed a Transmittal Letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee and an executed declaration.

On 14 February 2006, the United States Designated/Elected Office (DO/EO/US) mailed a Notification Of Missing Requirement (Form PCT/DO/EO/905) indicating that an executed declaration in compliance with 37 CFR 1.497 and the surcharge for filing the declaration later than thirty months after the priority date were required. The Notification stated that the declaration filed 13 June 2005 was not acceptable because it was not legible and because it did not identify the specification to which it was directed.

<sup>1</sup> The petition references both 37 CFR 1.47(a) and 1.47(b); however, because one of the co-inventors has executed the declaration herein, the applicable regulation is 37 CFR 1.47(a).

On 16 June 2006, applicants filed a response to the Notification Of Missing Requirements (with required two month extension fee). The submission includes the required surcharge payment, a revised declaration executed by co-inventor Andreas SPERLICH, and the petition under 37 CFR 1.47(a) considered herein. The petition seeks acceptance of the application without the signature of co-inventor Ian B. BIGHAM, whom applicants assert has refused to execute the revised declaration.

### **DISCUSSION**

#### **1. The Declaration Filed 13 June 2005:**

Initially, it must be determined if the declaration filed 13 June 2005 can be accepted under 37 CFR 1.497, because if this fully-executed declaration is acceptable, the petition under 37 CFR 1.47(a) is moot.

The Notification Of Missing Requirements stated that the declaration filed 13 June 2005 was defective for failure to properly identify the specification to which it was directed. In the present petition, applicants assert that a copy of the present specification accompanied the declaration filed 13 June 2005 when it was executed, evidencing the inventors' intent to execute the present application. Applicants also note that the declaration bears the docket number used on all other paper work filed with respect to the present national stage application.

MPEP § 602(VI) sets forth the minimum information required for a declaration to adequately identify the application to which it is directed:

The following combination of information supplied in an oath or declaration filed on the application filing date with a specification are acceptable as minimums for identifying a specification and compliance with any one of the items below will be accepted as complying with the identification requirement of 37 CFR 1.63:

(A) name of inventor(s), and reference to an attached specification which is both attached to the oath or declaration at the time of execution and submitted with the oath or declaration on filing;

(B) name of inventor(s), and attorney docket number which was on the specification as filed; or

(C) name of inventor(s), and title of the invention which was on the specification as filed.

The declaration filed 13 June 2005 does not satisfy any of these options. With respect to option (A), while the declaration does refer to an attached specification; no such specification was "submitted with the oath or declaration on filing," as required. With respect to option (B), a specification bearing the docket number set forth on the declaration was not filed with the

declaration, as required. Finally, with respect to option (C), the declaration does not bear the title of the invention.

Because the declaration filed 13 June 2005 does not satisfy the minimum requirements for identifying the application to which it was directed, as set forth in the MPEP, the declaration can not be accepted under 37 CFR 1.497. Consideration of the partially executed declaration filed 16 June 2006, and the accompanying petition under 37 CFR 1.47(a), is therefore required.

**2. Petition Under 37 CFR 1.47(a):**

A grantable petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17; (2) a statement of the last known address of the non-signing inventor; (3) an oath or declaration executed by the other inventors on behalf of themselves and the non-signing inventor; and (4) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort.

Applicants here have submitted the required petition fee. Item (1) is therefore satisfied.

The petition does not include an express statement of the last known address of the non-signing inventor. Item (2) is therefore not satisfied.

Regarding item (3), section 409.03(a) of the Manual of Patent Examining Practice (MPEP) states that:

An oath or declaration signed by all the available joint inventors with the signature block of the nonsigning inventor(s) left blank may be treated as having been signed by all the joint inventors on behalf of the nonsigning inventor(s), unless otherwise indicated.

Here, the petition includes a revised declaration that is legible, clearly identifies the application to which it is directed, is executed by co-inventor Andreas SPERLICH, and includes an unsigned signature block for the non-signing inventor. This declaration may be treated as having been executed by the signing inventor on his own behalf and on behalf of the non-signing inventor. Accordingly, item (3) is satisfied.

Regarding item (4), the present record is insufficient to support the conclusion that the inventor has refused to sign the revised declaration. Pursuant to MPEP section 409.03(d), before it can be concluded that an applicant refuses to sign the application papers, firsthand evidence must be provided confirming that a copy of the complete application (including specification drawings and claims) has been sent to the last known address of the inventor. The present petition includes a statement from co-inventor Andreas SPERLICH providing firsthand evidence regarding Mr. SPERLICH's unsuccessful attempts to deliver the application documents to the non-signing inventor for signature. The statement also refers to the required mailing of a request for signature, accompanied by a copy of the complete application papers, to the last known address of the non-signing inventor (via DHL courier). However, it was apparently Ted C. GILLESPIE, not Mr. SPERLICH, who carried out this required mailing. Accordingly, a

statement from Mr. GILLESPIE is required to provide firsthand confirmation of this mailing and the inventor's failure to respond thereto; such statement should be accompanied by available documentary evidence, such as the DHL delivery confirmation. Until such additional materials are provided, item (4) is not considered satisfied.

Based on the above, applicants have failed to satisfy all the requirements for a grantable petition under 37 CFR 1.47(a).

### **CONCLUSION**

Applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of the petition is desired, a proper response must be filed within **TWO (2) MONTHS** of the mail date of the present decision. Any request for reconsideration should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)" and must include the materials required to satisfy items (2) and (4) of a grantable petition, as discussed above. No additional petition fee is required.

Failure to file a proper response will result in abandonment of the application. Extensions of time are available under 37 CFR 1.136(a)

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



Richard M. Ross  
Attorney Advisor  
Office of PCT Legal Administration  
Telephone: (571) 272-3296  
Facsimile: (571) 273-0459